

REMARKS**I. PRELIMINARY REMARKS**

No claims have been amended, added or canceled. Claims 30, 31, 33-44, 46-61 and 63-73 remain in the application. Reexamination and reconsideration of the application, as amended, are respectfully requested.

Applicant notes with appreciation that claims 40-44, 46-49, 60, 61 and 63-69 have been allowed.

II. REJECTION UNDER 35 U.S.C. § 103**A. The Rejection**

Claims 30, 31, 33-39, 50-59 and 70-73 have been rejected under 35 U.S.C. § 103 as being unpatentable over the combined teachings of the Lundquist patent (U.S. Patent No. 5,395,327 and the Webster patent (U.S. Patent No. 5,827,278). The rejection under 35 U.S.C. § 103 is respectfully traversed with respect to the claims as amended above. Reconsideration thereof is respectfully requested.

B. Claims 30, 31, 33-39, 50-59 and 70-73

Independent claim 30 calls for a combination of elements including, *inter alia*, "a hollow catheter body having a side wall and an aperture," "a steering center support located within the catheter body," "adhesive material ... securing the hollow catheter body to the steering center support" and "**adhesive material in the side wall aperture that is substantially the same color as the catheter body.**" Claims 31, 33-39, 50, 51 and 70-72 depend from independent claim 30 and the combinations defined thereby include, *inter alia*, the elements recited in claim 30.

Independent claim 52 calls for a combination of elements including, *inter alia*, "a hollow catheter body including ... a side wall and an aperture extending through a predetermined portion of the side wall," "at least one internal component," "adhesive material located within the hollow catheter body securing the proximal member distal region to the at least one internal component" and "**adhesive material in the side wall aperture that is substantially the same color as the catheter body.**" Claims 53-59 and 73 depend from independent claim 52 and the combinations defined thereby include, *inter alia*, the elements recited in claim 52.

There are a variety of advantages associated with the inventions defined by claims 30, 31, 33-39, 50-59 and 70-73. For example, some side wall apertures are large enough to be noticeable after the catheter assembly process has been completed. A visible aperture may be interpreted as defect, or as an indication that the catheter is of low quality. The use of adhesive material that is substantially the same color as the catheter body solves this problem by making the aperture far less visible.

C. Discussion

The cited references fail to teach or suggest the claimed combinations. For example, the Lunquist patent fails to teach or suggest a catheter body with a side wall aperture and adhesive material within the side wall aperture. The Webster patent discloses that adhesive material may be transferred into a catheter body by way of an aperture. [See, e.g., column 4, lines 32-40 and column 5, lines 19-25.] The Webster patent does not, however, disclose that adhesive material which is within an aperture (note Figure 4) is substantially the same color as the catheter body.

The Office Action recognizes this clear difference between the claimed inventions and the cited references and seeks to justify the rejection with the statement that "[t]o have provided an adhesive material [that is] the same color as the catheter body would have been an obvious design choice." [Office Action at page 3.] This conclusory statement is traversed for a variety of reasons. First, the Office Action does not provide a single reason or fact in support of the conclusion that the specific choice of adhesive

material (i.e. adhesive materials that is substantially the same color as the associated catheter body) would have been an obvious design choice.¹ The Office Action also failed to cite a reference which indicates that, in the context of catheters, the color of the adhesive is something that should even be taken into account in the design process. Finally, given the fact that the use of adhesive that is substantially the same color as the catheter body solves the problem discussed in Section II-B above, an "obvious design choice" rejection is inappropriate.²

In view of the foregoing, applicant respectfully submits that the Office Action fails to establish a *prima facia* case of obviousness with respect to independent claims 30 and 52 and that the rejection of claims 30, 31, 33-39, 50-59 and 70-73 under 35 U.S.C. § 103 should be withdrawn.

III. CLOSING REMARKS

In view of the foregoing, it is respectfully submitted that the claims in the application are in condition for allowance. Reexamination and reconsideration of the application, as amended, are respectfully requested. Allowance of the claims at an early date is courteously solicited.

If for any reason the Examiner finds the application other than in condition for allowance, the Examiner is respectfully requested to call applicant's undersigned representative at (310) 563-1458 to discuss the steps necessary for placing the application in condition for allowance.

¹ In the event that the phrase "obvious matter of design choice" has been used to indicate that the Examiner has taken "judicial notice" with respect to knowledge generally available in the art, applicant hereby requests that the Examiner provide an affidavit in accordance with MPEP § 2144.03 and 37 C.F.R. § 1.104(d)(2) to that effect. The affidavit should set forth the facts upon which the Examiner's conclusions regarding the knowledge available in the art are based. Otherwise, applicant respectfully requests that the Examiner provide a prior art reference which shows that the claimed invention would have been obvious.

² See *In re Kuhle*, 188 USPQ 7, 9 (CCPA 1975) (the fact that a modification to a prior art device solved no stated problem used as rationale for an "obvious matter of design choice" holding).

The Commissioner is hereby authorized to charge any additional fees which may be required, or credit any overpayment to Deposit Account No. 50-0638. Should such fees be associated with an extension of time, applicant respectfully requests that this paper be considered a petition therefor.

2/22/05
Date

Respectfully submitted,



Craig A. Slavin
Reg. No. 35,362
Attorney for Applicant

Henricks, Slavin & Holmes LLP
840 Apollo Street, Suite 200
El Segundo, CA 90245
(310) 563-1458
(310) 563-1460 (Facsimile)